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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,984	11/30/2000	Steve Lemke	PALM-3280.US.P	6291
49637	7590	09/08/2005	EXAMINER	
BERRY & ASSOCIATES P.C. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES, CA 90069			PICH, PONNOREAY	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/727,984

Applicant(s)

LEMKE, STEVE

Examiner

Ponnoreay Pich

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1, 8, 13, 14, and 19 were amended. Claim 7 was cancelled. Claims 1-6 and 8-22 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The previous office action(s) is/are incorporated by reference in its/their entirety. The examiner assumes that the applicant agrees with any well-known prior art statements and/or rejections made by the examiner in the previous office action(s) that were not argued. Any objections or rejections not repeated below for record are withdrawn due to applicant's amendments and/or arguments.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/2/2005 has been entered.

Docketing

Please note that the application has been redocketed to a different examiner. Please refer all future communications regarding this application to the examiner of record using the information supplied in the final section of the office action.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Specification

The disclosure is objected to because of the following informalities: On page 16 of the specification, the examiner submits that applicant may have meant to recite on line 11, "If not programmed, ...".

Appropriate correction is required.

Claim Objections

Claim 8 is objected to because of the following informalities: As per claim 8, the examiner assumes the last sentence should read "preventing access **if**" instead of "preventing access in". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 1 recites "the user" and "said user". It is unclear if both "the user" and "said user" refer to the same "a user" recited in line 4.
2. As per claim 1, it is unclear if the "said biometric data" recited in line 8 refers to the biometric data stored in the portable computing device or the biometric data stored in said computer network. Similar problems exist for the "said biometric data" recited in claims 3-6.
3. Claim 1 recites "said data comparison" in line 10, which lacks antecedent basis.

4. As per claim 8, the examiner submits that the second limitation as recited seems to lack an essential step as it is unclear how merely storing said biometric data with previously stored biometric data is useful for identifying the user. The examiner submits that perhaps applicant meant to recite "comparing" instead of "storing".
5. Claim 8 recites "said computer network" in lines 6-7 which lacks antecedent basis.
6. As per claim 8, it is unclear to which biometric data the "said biometric data" recited in line 7 refers. Similar problems exist for the "said biometric data" recited in claims 9-12.
7. Claim 12 recites "said computer network" which lacks antecedent basis.
8. Claim 13 recites "said workstation" in the last line, which lacks antecedent basis. The examiner submits that perhaps applicant meant to recite "said one of said workstations".
9. Claim 14 recites "said biometric data" and "said biometric data stored in said memory unit" in lines 13-14. It is unclear to which biometric data "said biometric data" refers. The examiner further submits that "said biometric data stored in said memory unit" lacks antecedent basis.
10. As per claim 16, it is unclear if "the portable computing apparatus" refers to the same "portable computing apparatus" earlier being referred to by "said portable computing apparatus."
11. Any claims not specifically addressed are rejected by virtue of dependency.

12. Appropriate corrections are required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borza et al (WO 98/12670) in view of Deo et al (US 6,496,928).

Claim 1:

Borza discloses a method for controlling access to a computer network comprising:

1. Gaining access to said computer network by use of a portable computing device (p5, lines 18-24)
2. Reading biometric data peculiar to a user by the use of a biometric data reader coupled to said portable computing device (p8, lines 16-17 and p9, lines 11-15).
3. Comparing said biometric data to biometric data stored in said computer network for the purpose of identifying the user (p8, lines 27-28 and p15, lines 10-25).
4. A remotes station retaining a copy of said biometric data (p8, lines 27-28 and p15, lines 10-25).
5. Denying further access to said computer network if said data comparison fails to identify said user as an authorized user (p15, lines 10-25 and Fig 8, item 40).

Borza does not disclose "wherein said biometric data is operable to be removed from said portable computing device on instruction by a remote station on said computer network". However, Deo discloses a remote station transmitting a programming message to a portable computing device with instructions for the portable computing device to remove authorization data from its memory (col 24, lines 3-17). The examiner asserts that biometric data as disclosed by Borza is authorization data. Therefore, in light of the above, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Borza's invention according to the limitations recited in claim 1. One of ordinary skill would have been motivated to do so as Deo discloses that his teachings would allow for a content provider or wireless carrier with the ability to turn off services to individual users of mobile devices (col 28, lines 49-52), which provides efficient subscription management (col 22, lines 47-48).

Claim 2:

Borza further discloses wherein said access to said computer network is by use of a wireless connection (p7, lines 28-30).

Claim 3:

Borza further discloses said biometric data is a fingerprint (p9, lines 13-15).

Claim 4:

Borza further discloses wherein said biometric data is an iris scan (p11, lines 18-21).

Claim 5:

Borza further discloses wherein said biometric data comprises one or more measured electrical characteristics (p8, lines 13-17).

Claim 6:

Borza does not disclose said biometric data can be programmed into said portable computing device by a remote station on said computer network. However, as mentioned, biometric data is authorization data. Further, Deo discloses authorization data can be programmed into a portable computing device by a remote station on a computer network (col 23, lines 19-24). Therefore, the above limitation is obvious to the combination invention of Borza and Deo

Claim 8:

Borza discloses a method for controlling access to a portable computing device, comprising:

1. Reading biometric data peculiar to a user (p8, lines 16-17 and p9, lines 11-15).
2. Storing said biometric data with previously stored biometric data for purpose of identifying the user (p9, line 19-p9line 2).
3. A remote station retaining a copy of said biometric data (p8, lines 27-28 and p15, lines 10-25).
4. Preventing access if the user is not identified as an authorized user (p15, lines 10-25 and Fig 8, item 40).

Borza does not disclose wherein said biometric data is operable to be removed from said portable computing device on instructions by a remote station. However, Deo discloses a remote station transmitting a programming message to a portable computing device with instructions for the portable computing device to remove authorization data from its memory (col 24, lines 3-17). The examiner asserts that biometric data as disclosed by Borza is authorization data. Therefore, in light of the above, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Borza's invention according to the limitations recited in claim 8. One of ordinary skill would have been motivated to do so as Deo discloses that his teachings would allow for a content provider or wireless carrier with the ability to turn off services to individual users of mobile devices (col 28, lines 49-52), which provides efficient subscription management (col 22, lines 47-48).

Claim 9:

Claim 9 recites a limitation substantially similar to claim 3 and is rejected for the same reasons.

Claim 10:

Claim 10 recites a limitation substantially similar to claim 4 and is rejected for the same reasons.

Claim 11:

Claim 11 recites a limitation substantially similar to claim 5 and is rejected for the same reasons.

Claim 12:

Claim 12 recites a limitation substantially similar to claim 6 and is rejected for the same reasons.

Claim 13:

Borza discloses an apparatus for controlling access to a computer network comprising:

1. A computer network, said computer network comprising one or more computer workstations, wherein access to said computer network is provided by said workstations (p8, line 27-p9, line 1).
2. A portable computing device, said portable computing device providing wireless access to said computer network (p7, line 27-p8, line 3).
3. A biometric data reading device coupled to said portable computing device (p8, lines 16-17).
4. A data storage device for storing biometric data capable of identifying one and only one user (p8, line 27-p9, line 2).
5. A workstation retaining a copy of said biometric data (p8, lines 27-28 and p15, lines 10-25).

Borza does not disclose a wireless communication device coupled to said computer network, capable of enabling the loading and removing of said biometric data stored in said portable computing device, and wherein said biometric data is operable to be removed from said portable computing device on instructions by one of said workstations on said computer network.

However, Deo discloses a wireless communication device coupled to said computer network, capable of enabling the loading and removing of authorization data stored in said portable computing device (col 23, lines 19-24 and col 24, lines 3-17), and wherein said authorization data is operable to be removed from said portable computing device on instructions by one of said workstations on said computer network (col 23, lines 19-24).

In light of the above, it would have been obvious to one of ordinary skill in the art to have modified Borza's invention according to the limitations recited in claim 13. One of ordinary skill would have been motivated to do so as Deo discloses that his teachings would allow for a content provider or wireless carrier with the ability to turn off services to individual users of mobile devices (col 28, lines 49-52), which provides efficient subscription management (col 22, lines 47-48).

Claim 14:

Borza further discloses said portable computing apparatus comprises:

1. A bus (Fig 6).
2. A memory unit coupled to said bus (p9, lines 1-2).
3. A data storage device coupled to said bus, capable of storing said biometric data (p9, lines 1-2).
4. A biometric data reader coupled to said bus (p8, lines 16-17).
5. A communication device coupled to said bus for communicating with a computer network (Fig 6, item 19).

6. A processor couple to said bus (Fig 6, item 12), said processor for performing a method for identifying a user by use of said biometric data, said method comprising the steps of:
- a. Reading applicable biometric data (p3, lines 27-30).
 - b. Comparing said biometric data with said biometric data in said memory unit (p3, lines 27-30).

Claim 15:

Borza does not disclose said portable computing apparatus is a personal data assistant (PDA). However, the limitation is obvious to the combination invention of Borza and Deo as Deo discloses portable computing apparatus are personal data assistants (col 1, lines 27-28).

Claim 16:

Borza further discloses said biometric data reader is implemented as part of the portable computing apparatus (p8, lines 16-17).

Claims 17 and 18:

Claims 17 and 18 recite limitations substantially similar to claims 3 and 4 respectively and are rejected for the same reasons.

Claim 19:

Borza further discloses said biometric data is any electronically storable identifying biometric data (p8, lines 13-17).

Claim 20:

Claim 20 is substantially similar to claim 5 and is rejected for the same reasons.

Claim 21:

Borza further discloses said computer network further comprises a remote station connected to said computer network (p8, lines 19-20 and line 29-p9, line 1).

Claim 22:

Borza further discloses wherein said remote station is for performing a method of network access control (p8, lines 27-29). Borza further discloses said method comprising uploading said biometric data from said portable computing apparatus (p8, lines 19-20). Borza does not disclose said method comprising:

1. Downloading said biometric data to said portable computing device.
2. Erasing said biometric data from said portable computing apparatus.

However, the examiner asserts that biometric data is authorization data. Further, Deo discloses downloading authorization data to a portable computing apparatus and erasing authorization data from a portable computing apparatus (col 23, lines 19-24 and col 24, lines 3-17). Therefore, the above limitations not met by Borza are obvious to the combination invention of Borza and Deo.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 8:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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